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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,073	02/08/2002	Nicole Chantel Barvian	A0000518-01-CFP	3386

28880 7590 04/18/2003

WARNER-LAMBERT COMPANY
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EXAMINER
FAN, JANE T

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 04/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,073

Applicant(s)

BARVIAN ET AL.

Examiner

Jane T. Fan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 2,4,7,9,13,15,19,20,22-24,26,28 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10,25,27,29-33 and 35 is/are rejected.
- 7) ☒ Claim(s) 1,3,5,6,8,10-12,14,16-18,21,27,29-33 and 35 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other:

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1,3, 5-6, 10-12, 14, 16-18, 21, 25, 27, 29-33, 35, drawn to pyridine-2,4-dicarboxylic acid diamides as presented in claim 10 wherein Ar is 1,3-benzodioxol for treating osteoarthritis, classified in classes 514, 546 subclasses various.
 - II. Claims 1,3, 5-6, 10-12, 14, 16, 18, 21, 25, 27, 29-33, 35, drawn to pyridine-2,4-dicarboxylic acid diamides as presented in claim 10 wherein Ar is phenyl optionally substituted , classified in classes 514, 546 subclasses various. If this group is elected, an election of a single disclosed method of use (a single disease) is required.
 - III. Claims 6, 7, 9, 11-13, 15, 17,30-32 drawn to pyridine-2,4 dicarboxylic acid esters, classified in classes 514,546,544, subclasses various. If this group is elected, an election of a single disclosed species is required. Linking method claims 1,2,4,18-26,28,33-35 may be prosecuted together with the elected compound upon election of a single disclosed disorder(a single disease) relevant to the elected compounds.
 - IV. The remaining compounds from the above groups. If this group is elected, an election of a single disclosed species is required. Linking method claims may be prosecuted together with the elected compound upon election of a single disclosed disorder(a single disease) relevant to the elected compounds.

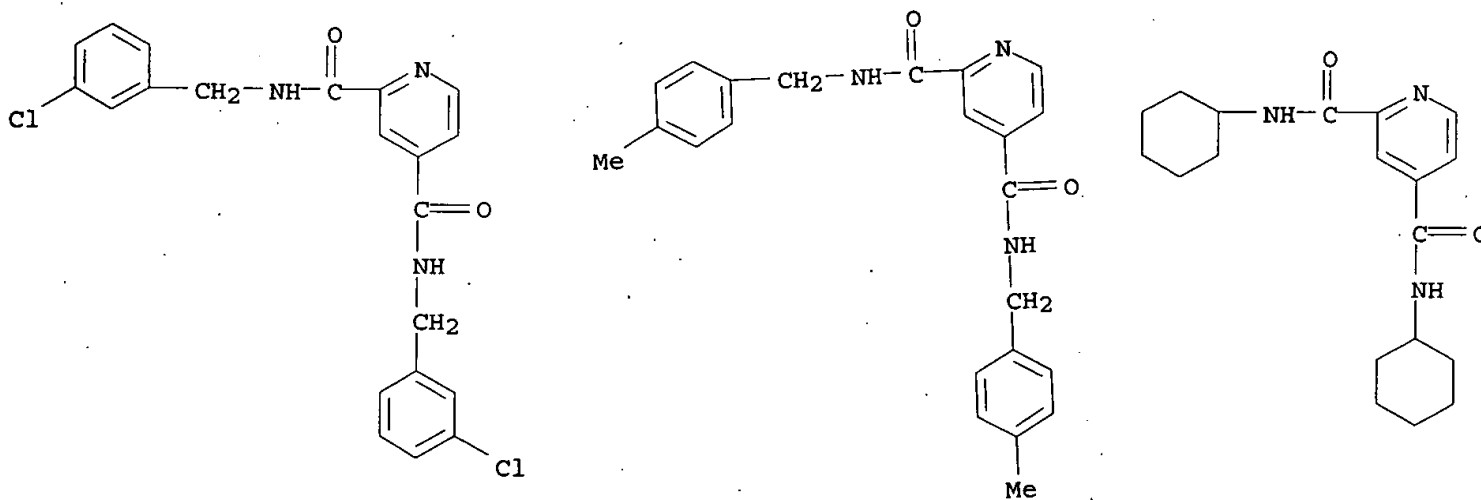
The inventions are distinct, each from the other because of the following reasons:

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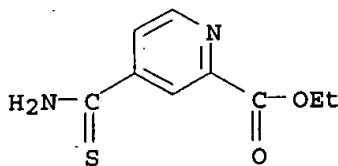
The compounds of the groups above are independent and distinct since they differ greatly in chemical structure. The above groups would not be classified together under a scientific mode of classification. The compounds of group I would not be a reference under 35 USC 103 against the compounds of group II-III. Further note that the heterocyclic moieties cannot be considered as conventional substituents, but rather form a new core of the molecule each time that they are present. Since no common core is present, the inventions are misjoined.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, note the following **are all 102 references**:

1. patent 5,260,323 teaches the following compounds:

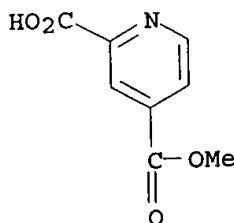


2. patent 6,043,263 teaches the following compound:

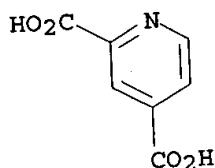


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3. patent 5,852,038 teaches the following compound:



4. patent 5,219,847 teaches the following compound:



The above is just a sample of 102 references. There are numerous 103 references such as pat'6,307,049; WO 2000058288. The list is too long . The evidence or admission may be used in a rejection under 35 USC 103 of the other invention.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Purchase on April 11with, 2003 a provisional election was made with traverse to prosecute the invention of group I, claims 1,3, 5-6, 10-12, 14, 16-18, 21, 25, 27, 29-33, 35, drawn to pyridine-2,4-dicarboxylic acid diamides as presented in claim 10 wherein Ar is 1,3-benzodioxol for treating osteoarthritis. Affirmation of this election

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claim 10 wherein Ar is 1,3-benzodioxol for treating osteoarthritis. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2,4,7,9,13,15,19-20,22-24,26,28,34 and the subject matter of 1,3, 5-6, 10-12, 14, 16-18, 21, 25, 27, 29-33, 35 outside of what is elected are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10, 25, 27, 29-33, 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. Claims 15, 27, 29-33, 35 are substantial duplicates of claims 1,3,5,6,8,10-12,14,16-18.
2. Claim 10 is improper since the definition of R4, R5 does not appear in the structural formula.

6. Claims 1,3,5-6, 8,¹⁰~~10~~-12, 14,16-18, 21,25,27, 29-33,35 are objected to. Deleting the non-elected subject matter and rewriting the method claim as –A method for treating osteoarthritis by inhibiting a MMP-13 enzyme in a patient , comprising administering to a patient in need of such treatment an effective MMP-13 inhibitory amount of a compound of claim--. *would overcome the objection.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane T. Fan whose telephone number is 703-308-4705. The examiner can normally be reached on 7:00am-3:30pm, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-308-4734 for regular communications and 703-308-4734 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Jane T. Fan
Primary Examiner
Art Unit 1625

April 15, 2003


JANE FAN
PRIMARY EXAMINER
GROUP 1200